

### III. REMARKS

1. Claim 1 is amended. Claims 1-8 are pending.
2. Claim 1 is amended to overcome the rejection under 35 U.S.C. 112, second paragraph.
3. Claims 1-3, 7 and 8 are patentable under 35 U.S.C. 103(a) over Ladds et al., U.S. Pat. No. 4,155,643 ("Ladds") and Haydock, U.S. Pat. No. 2,963,761 ("Haydock"). Claim 1 recites the mail item receiving device comprising a rear wall intended to align these mail items once they have fallen on the support plate. The combination of Ladds and Haydock fails to disclose or suggest at least this feature.

Ladds discloses a photocopy receiver tray (32) having hooks (35 and 36), bottom (34) and a pair of upturned stops (38, 40) for arresting motion of the delivered photocopies. Stops (38, 40) are separated by slot (42) which allows the copies to be grasped for removal. Hooks (35, 36) fit within slots (44 and 46) of machine end wall (28) and are formed as extensions of side members (48, 50), the forward edges of which abut end wall (28). The hooks (35, 36) and the forward edges of side members (48, 50) serve as means for removably mounting the tray to the machine in position to receive copies, and are adapted to dispose the tray bottom (34) at a downward tilt or decline toward stops (38, 40) to aid by gravity delivery of copies to the stops. (Col. 2, L. 24-38).

The Examiner notes that the tray of Ladds "does not specifically disclose a rear wall intended to align these mail items once they have fallen on the support plate". The Examiner argues "that it is clear from Figure 3 [of Ladds] that the machine itself acts as the rear wall" and that it would have been obvious to one of

ordinary skill in the art "to have added a rear wall to the tray for purposes of keeping the mail items from falling out". However, this is not what is claimed by Applicant. Claim 1 recites the mail item receiving device comprising "a rear wall intended to align these mail items once they have fallen on the support plate". The tray (32) in Ladds is angled downward away from the copier (i.e. the rear wall) so that the copies fall against the stops (38, 40) (Col. 2, L. 32-38). A rear wall on the tray (32) of Ladds would not serve to keep the copies from falling out or, as recited by Applicant, to align the mail items. Therefore, it would not have been obvious to add a rear wall to the tray (32) of Ladds to align the mail items.

It is further submitted that there is absolutely no reason in Ladds to add a rear wall to the tray (32) of Ladds. In Ladds, the attachment point between the tray (32) and the photocopier made via the hooks (35, 36), which are located on the sides (48, 50) of the tray (32) and the slots (44, 46) of the machine end wall (28). Thus, there is no reason to add a rear wall to the tray for attaching the tray (32) to the copier. Further, the sheets of paper that are received by the tray (32) in Ladds fall against the stops (38, 40) via the force of gravity. Thus, there is no reason to add a rear wall to the tray (32) for aligning the paper. The Examiner's modification of adding a rear wall to Ladds is made with the impermissible use of hindsight in light of Applicant's disclosure. Even if one were to add a rear wall to the tray (32) in Ladds the rear wall would not align mail items as recited by Applicant

Combining Ladds with Haydock fails to remedy the above deficiency. Haydock discloses a tray for attachment to a foldable table. Nowhere does Haydock disclose or suggest the

tray having "a rear wall intended to align these mail items once they have fallen on the support plate" as recited by Applicant. Thus, claim 1 is patentable over the combination of Ladds and Haydock at least for this reason.

In addition, claim 1 recites that the rear wall of the mail item receiving device comprises hooking means cooperating with feet of the machine for connecting the receiving device to the folding and inserting machine. The Examiner notes that Ladds does not disclose or suggest this feature. However, the Examiner argues that Haydock discloses this feature. Applicant respectfully disagrees.

Haydock merely discloses a tray for attachment to a table. The tray in Haydock is not disclosed as receiving mail items. Further, Haydock merely discloses the clips for attachment to the table. There is absolutely no disclosure in Haydock of any other features of the tray, other than the disclosed clips. Therefore, Haydock does not disclose or suggest that the rear wall of the mail item receiving device comprises hooking means cooperating with feet of the machine for connecting the receiving device to the folding and inserting machine. Thus, claim 1 is patentable over the combination of Ladds and Haydock for this additional reason. Claims 2-8 are patentable at least by reason of their respective dependencies.

Moreover, it is respectfully submitted that there is no legal motivation to combine Ladds with Haydock. In order to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of

success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142). As noted above, the combination of Ladds and Haydock does not disclose or suggest each feature of Applicant's claims. Thus, a *prima facie* case of obviousness cannot be established.

Neither Ladds nor Haydock provide any suggestion or motivation to be combined or modified as proposed by the Examiner and the Examiner's proposition that Applicant's invention would be obvious as recited in the claims is not supported by the factual contents of Ladds or Haydock.

The tray (32) in Ladds is angled downward away from the copier (i.e. the rear wall) so that the copies fall against the stops (38, 40) (Col. 2, L. 32-38). Motivation for purposes of 35 U.S.C. 103(a) requires that the reference itself and/or the knowledge generally available to one of skill in the art provide the requisite motivation or suggestion to modify the reference.

In Ladds, a rear wall on the tray (32) would not serve to keep the copies from falling out or to, as recited by Applicant, align the mail items. Haydock merely discloses a tray for attachment to a foldable table. There is absolutely no motivation in either of the references to modify or combine the reference teaching as suggested by the Examiner to obtain what is claimed in Applicant's claims.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1057 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference.

Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Ladds and Haydock under 35 U.S.C. 103(a) is not established.

It is further submitted that Ladds and Haydock have been combined improperly. References may be combined under 35 U.S.C. 103(a) only if the references are analogous art. In this case, Ladds and Haydock are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonable pertinent to the particular problem with which the applicant was concerned.

Neither Ladds nor Haydock are in the same field as the Applicant's. Ladds is directed to a device for receiving sheets of paper from a photocopier. Haydock discloses a tray for attachment to a collapsible table. On the other hand, Applicant's claims recite a mail item receiving device for receiving the mail items ejected through an exit slot of a folding and inserting machine. Photocopiers and collapsible tables are not in the same field of endeavor as a mail item folding and inserting machine. Similarly, Ladds and Haydock are not reasonably pertinent to the particular problem with which the Applicant is concerned (e.g. a mail item receiving tray that does not require it to be withdrawn in order to extract the mail items held therein). Again, Ladds is concerned with photocopier trays and Haydock is concerned with trays for collapsible tables.

Since Ladds and Haydock are not in the same field of endeavor as the Applicant's and are not reasonably pertinent to the particular problem with which the Applicant was concerned, Ladds

and Haydock are not analogous are. Therefore, Ladds may not properly be combined with Haydock.

4. Claim 4 is patentable under 35 U.S.C. 103(a) over Ladds, Haydock and Hrenyo, U.S. Pat. No. 5,018,623. Claim 4 recites that the rear wall integrating the hooking means is reinforced by ribs. The Examiner notes that Ladds does not disclose reinforcing ribs. Haydock also does not disclose or suggest reinforcing ribs (see Figs. 1-6 and Col. 3, L. 14-15 "the clip is smooth on all external surfaces"). The Examiner argues that Hrenyo when combined with Ladds and Haydock discloses the features of claim 4. However, there is no motivation to combine Hrenyo with Ladds and Haydock.

Hrenyo merely discloses a plastic overwrap packaging tray for holding processed meat (Col. 1, L. 10-11); Haydock merely discloses a tray for attachment to a foldable table; and Ladds discloses a photocopy receiver tray. One skilled in the art would not be motivated to look to Hrenyo's tray for holding processed meat or to Haydock's tray for attachment to a foldable table to modify the photocopy receiver tray of Ladds as suggested by the Examiner to arrive at the mail item receiving device recited in Applicant's claim 4.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1057 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Ladds and Haydock under 35 U.S.C. 103(a) is not established.

Moreover, Ladds, Haydock and Hrenyo have been improperly combined and are non analogous art. Ladds and Haydock are not in the same field of endeavor as Applicant's and are not reasonably pertinent to the problem Applicant was concerned for the reasons described above. Hrenyo is not in the same field of endeavor as Applicant's nor is it reasonably pertinent to the problem addressed by Applicant because Hrenyo is directed to trays for holding processed meat not mail items. Therefore, Ladds, Haydock and Hrenyo may not properly be combined.

In addition, claim 4 depends from claim 1. As described above, the combination of Ladds and Haydock does not disclose or suggest all the features of claim 1. It is submitted that the combination of Ladds, Haydock and Hrenyo cannot as well.

Nowhere does Hrenyo disclose or suggest a tray for receiving mail items having "a rear wall intended to align these mail items once they have fallen on the support plate" or that the mail item receiving device comprises hooking means cooperating with feet of the machine for connecting the receiving device to the folding and inserting machine as recited in claim 1. Thus, claim 1 is patentable over the combination of Ladds, Haydock and Hrenyo. Claim 4 is patentable at least by reason of its respective dependency.

5. Claim 5 is patentable under 35 U.S.C. 103(a) over Ladds, Haydock and Firl et al., U.S. Pat. No. 5,454,553 ("Firl"). Claim 5 depends from claim 1 and as described above the combination of Ladds and Haydock fails to disclose or suggest all the features of Applicant's claim 1. It is submitted that because the combination of Ladds and Haydock fails to disclose or suggest all the features of claim 1 that the combination of Ladds, Haydock

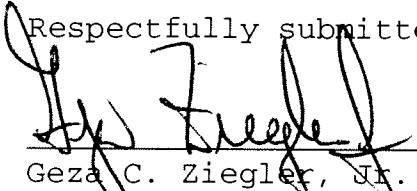
and Firl cannot as well. Claim 5 is patentable at least by reason of its dependency.

6. Claim 6 is patentable under 35 U.S.C. 103(a) over Ladds, Haydock and Japanese Patent No. 8-337349 ("Ricoh"). Claim 6 depends from claim 1 and as described above the combination of Ladds and Haydock fails to disclose or suggest all the features of Applicant's claim 1. It is submitted that because the combination of Ladds and Haydock fails to disclose or suggest all the features of claim 1 that the combination of Ladds, Haydock and Ricoh cannot as well. Claim 6 is patentable at least by reason of its dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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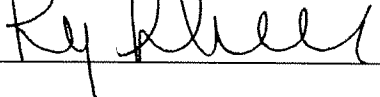
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